

REMARKS/ARGUMENTS

Claims 1-14 are pending in this application with claims 7-14 having been withdrawn. Claims 1-5 have been amended. This amendment does not add new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,066,459 to Garini et al., hereafter Garini alone or optionally in view of U.S. Patent No. 5,414,260 to Takimoto et al., hereafter Takimoto. Reconsideration of the rejection and allowance of the claims are respectfully requested for the following reasons.

Claim 1 recites, in part, “moving the optical instrument and specimen relative to each other in a forward direction; detecting the first spectral signal using a first sensor while deactivating at least one of the second optical signal or a second sensor so as not to detect the second spectral signal; moving the optical instrument and specimen relative to each other in a reverse direction; and detecting the second spectral signal using the second sensor while deactivating at least one of the first optical signal or the first sensor so as not to detect the first spectral signal.”

Support for the amendments to claim 1 is found in the specification, for example at page 5, lines 13-17, which discusses deactivating “either the sensor 42b that reads the second dye, or the transmitter 12b that excites the fluorescent properties of the second dye.” Moreover, the original claims provide support for deactivating both the sensor 42b and the transmitter 12b. For example, original claim 4 (“scanning for only one of said spectral arrays in the forward direction”) is dependent on original claim 2 (“projecting only one of said spectral arrays in the forward direction”). Likewise, original claim 5 is dependent on original claim 3 with respect to deactivation of both the sensor and the transmitter in the reverse direction.

Applicants respectfully submit that at least the steps of detecting the first spectral signal using a first sensor while deactivating at least one of the second optical signal or a second sensor so as not to detect the second spectral signal and detecting the second spectral signal using the second sensor while deactivating at least one of the first optical signal or the first sensor so as

not to detect the first spectral signal is nowhere shown or suggested in either of the cited references, either taken alone or in combination. Accordingly, independent claim 1 is believed patentable over the cited references. The dependent claims are, by their terms narrower than the claims from which they depend, and are patentable for that reason alone.

Garini discusses a “spectral imaging method for simultaneous detection of multiple fluorophores. (Garini at Abstract). According to Garini, the methods he discloses enable “the simultaneous measurement of the emission spectrum of an unlimited number of fluorescent dyes,” thereby eliminating “the need for sequentially acquiring images of the emissions of multiple fluorescent probes.” (Garini at col. 24, lines 7-16). Thus, Garini teaches away from the present invention, in which fluorescence characterized by the first spectral signal, but not fluorescence characterized by the second spectral signal, is detected in the forward direction, and fluorescence characterized by the second spectral signal, but not fluorescence characterized by the first spectral signal, is detected in the reverse direction. On the contrary, Garini discusses a method for simultaneous detection of multiple fluorophores. (Garini at Abstract).

Furthermore, Takimoto does not make up for this deficiency in Garini. Takimoto does not teach or suggest at least the steps of detecting the first spectral signal using a first sensor but not the second spectral signal by deactivating at least one of the second optical signal or a second sensor and detecting the second spectral signal using the second sensor but not the first spectral signal by deactivating at least one of the first optical signal or the first sensor, as recited by claim 1. Takimoto discusses measuring physical features present on surfaces using a scanning probe microscope (scanning tunneling microscope (STM) or atomic force microscope (AFM)). However, Takimoto does not teach or suggest the method of scanning a specimen with an optical instrument as recited in claim 1.

Claims 2-6, are dependent on claim 1 and should be allowable for at least similar reasons as discussed for claim 1 above. Furthermore, claims 2-6 recite additional limitations and should be allowable for these additional reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



David N. Slone
Reg. No. 28,572

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
DNS:CCL:dd
60342424 v1